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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,734	05/27/2005	Joseph Itskovitz-Eldor	29601	3958

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ARLINGTON, VA 22215

EXAMINER

KIM, TAEYOON

ART UNIT	PAPER NUMBER
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1651

MAIL DATE	DELIVERY MODE
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12/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/536,734

Applicant(s)

ITSKOVITZ-ELDOR ET AL.

Examiner

TAEYOUN KIM

Art Unit

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. § 112.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: 195-198
Claim(s) rejected: 193, 195-200, 202, 205, 214 and 215
Claim(s) withdrawn from consideration: 194, 201 and 216-234

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/Leon B Lankford/
Primary Examiner, Art Unit 1651

Continuation of 11, does NOT place the application in condition for allowance because: In the response to the claim rejection under 35 U.S.C. §103, application argued that Lumelsky in view of Dang do not teach or suggest culturing the cells in a second set of conditions selected suitable for formation of surface bound cell clusters. It is correct that Dang does not teach this limitation. However, as the examiner stated in the previous office action, the condition of Lumelsky for nestin-positive pancreatic progenitor cells is considered as a suitable culturing condition. As indicated, Lumelsky does not teach a dissociation step of EBs. However, Dang teaches the use of FACS analysis to isolate cells having a specific marker from EBs, and since Lumelsky teaches that nestin-positive cells would differentiate into pancreatic cells, it would have been obvious to a person of ordinary skill in the art to dissociate EBs to isolate nestin-positive cells, and a person of ordinary skill in the art would have a reasonable expectation of success in using FACS analysis to isolate nestin-positive cells from EBs. The isolated nestin-positive cells then would be cultured in the culture condition for pancreatic cells taught by Lumelsky.

With regard to the limitation drawn to a culture condition suitable for formation of clusters while inhibiting growth of non-insulin producing cells, the examiner analyzed the culture condition of Lumelsky inherently carry out the limitation. Applicant traversed this analysis because Lumelsky directly plates the EBs and cultured them under the condition without dissociation of EBs into cells. As discussed in the previous office action as well as above, Dang teaches a method step of dissociation of EBs into a single cell for FACS analysis. As indicated above, it is obvious to select nestin-positive cells from EBs based on the teaching of Dang. The rejection is not based on only Lumelsky's teaching, rather it is based on the combination of Lumelsky and Dang's teachings. Furthermore, the specification of the current application discloses that the substantially serum free medium is one example of culture media for formation of cell clusters including insulin producing cells, and inhibiting growth of non-insulin producing cells (p.11, lines 6-12; p.13, lines 15-21). Since the ITSFn medium of Lumelsky is a serum free medium (para. 99), the use of ITSFn medium would inherently carry out the limitation of the claimed invention.

Based on the above analysis, the proposed amendment does not place the current application in condition for allowance.

Taeyoon Kim
AU-1651